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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,367

04/11/2006

Henri Rosset

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EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

03/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/575,367	Applicant(s) ROSSET, HENRI	
	Examiner Kyle Grabowski	Art Unit 3725	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 9-17 and 23-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725

/Kyle Grabowski/
Examiner, Art Unit 3725

Continuation of 3. NOTE: The additional limitation in claim 1, even though present previously in claim 24, does not put the claims in condition for allowance. The inclusion of claim 24 into claim 1 does not provide for allowable subject matter (see below). The additional limitations to claim 1 would require additional search and/or consideration for every claim dependent therefrom to determine if there were allowable subject matter within the dependent claims in the amended format.

Continuation of 11. does NOT place the application in condition for allowance because: In respect to independent claim 1, the applicant argues that "no explanation is given regarding why or how the pigment or dye of the "first ply" 20 could be absent from the "second ply" 10 in Murakami et al. ('276), however the examiner respectfully disagrees. Figure 5 is an embodiment having two paper layers which may use known paper making techniques such as a "combination of cylinder machines", the applicant contends that these types of machines "are generally provided with a single 'pulp circuit' feeding the different 'wet ends' with the same fiber suspension" without providing evidence of such. Murakami et al. (US 5,961,432) (previously cited) (Fig. 4) and Williams (US 3,880,706) (Fig. 2) are just two examples of combination machines with separate pulp tanks "vats" and no apparent disclosure of a shared pulp circuit. It is still held by the examiner that one reading the disclosure of Murakami et al. would look to a known single cylinder machine (Col. 5, 36-47) and combine them (Col. 6, 60-65), and either paper layer may be provided with dye (as known in the art). Furthermore, the claimed subject matter (incorporated from claim 24) does not require two different pulp materials i.e. if both paper layer 10 and 20 have the pulp and dye (with a shared pulp circuit, as contended) the recitation "wherein the second authentication element of the second ply is substantially disclose the claimed subject matter for the reasons stated above but do not disclose absent from the first ply" is still met. For example, omitting "of the second ply" would require the dye to be substantially absent from the first ply, however this part of the recitation only states that the second authentication elements of the second ply are absent from the first ply (which they inherently are, as the first and second plies are separate). In respect to claim 25, the application argues that it would not be obvious to add strengthening agent to only one ply, however the examiner disagrees. The first stated reason is that is "easier" to provide a unique paper stock, the same contention used above, and the examiner respectfully disagrees for the same reasons (i.e. a COMBINATION of single cylinder machines is disclosed). The second reason is that one would only look at the teaching to reinforce both layers of paper however the examiner respectfully disagrees; there are several advantages and disadvantages to a teaching and one of ordinary skill would reinforce the layers he/she would see to benefit from such an reinforcement.